

REMARKS

The applicant notes with appreciation the acknowledgement of the claim for priority under section 119 and the notice that all of the certified copies of the priority documents have been received.

The applicant acknowledges and appreciates receiving an initialed copy of the form PTO-1449 that was filed on September 16, 2003.

Claims 1 – 10 are pending. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1 and 4 were amended to remedy a cosmetic defect.

Claims 1, 2 and 4 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,878,368, DeGraaf ("DeGraaf"). The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Claim 1 recites, in combination, for example, "a commanding unit for commanding that the route searching unit select a route as giving priority to an automatic travel road where a vehicle can automatically travel." Positively guiding drivers of vehicles provided with automatic travel devices to automatic travel roads enables, e.g., smooth traffic flow.

The office action states that Claim 1 is unpatentable over DeGraaf, together with a modification proposed in the office action. There does not appear to be any motivation for the proposed modification. "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before

him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In order to establish obviousness by modifying the teachings of the prior art to produce the claimed invention, there must be some teaching, suggestion, or motivation. Such teaching, suggestion or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The office action admits that DeGraaf fails to teach or suggest the automatic travel road. The examiner argues that "'automatic travel road' is simply another type of special road for which the system of DeGraaf can be provided to indicate a user preference in route searching." However, no teaching, suggestion or motivation is provided for the proposed modification of DeGraaf.

To the contrary, DeGraaf fails to teach or suggest the invention, as presently claimed, when the claims are considered as a whole. DeGraaf fails to teach or suggests, for example, anything related to automatic travel, e.g., "giving priority to an automatic travel road where a vehicle can automatically travel", or "preferentially selects a route including a road that corresponds to the automatic travel road." (See, e.g., claim 1.)

DeGraaf fails to teach or suggest, for example, these elements recited in independent claim 1. It is respectfully submitted therefore that claim 1 is patentable over DeGraaf.

For at least these reasons, the combination of features recited in independent claim 1, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, DeGraaf clearly fails to show other claimed features as well.

With respect to rejected dependent claim 2, the applicant respectfully submits that this claim is allowable not only by virtue of its dependency from independent claim 1, but also because of additional features it recites in combination.

New claims 5 – 10 have been added to further define the invention, and are believed to be patentable for reasons including these set out above.

The applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, the applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

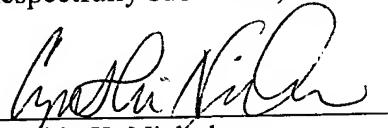
The applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples the applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicant respectfully submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Serial No. 10/662,284

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Cynthia K. Nicholson', written over a horizontal line.

Cynthia K. Nicholson

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